

**REMARKS/ARGUMENTS**

Upon entry of the above amendment, claims 1, 3, 4, 6, 7, 8, 9, 11, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30 and 32 will have been amended and are being submitted for reconsideration by the Examiner. Claims 2, 5, 7, 10, 12, 15, 17, 19, 21, 23, 25, 27, 29, 31 and 33 will have been canceled without prejudice or disclaimer. In addition a terminal disclaimer is attached hereto.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acknowledgment of Applicant's claim for priority under 35 U.S.C. §119 and for confirming receipt of the certified copy of the priority documents, as set forth in the Official Action.

Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 1, 2004, July 6, 2004, March 3, 2005, and December 12, 2006 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has rejected claims 1-33 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-5, 7-11, 13-17, 19, 20, 22, 23, 25, 26, 28, 29, 31, 32, 34, 35, 37, 38, 40, 41, 43 and 44 of U.S. Patent No. 7,095,524 to OGAWA. The Examiner has further rejected claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769) in view of BAEK et al. (U.S. Patent No. 5,798,845).

However, Applicant respectfully traverses the above rejections.

As noted above, Applicant has amended claims 1, 3, 4, 6, 7, 8, 9, 11, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30 and 32 for consideration by the Examiner, and has canceled claims 2, 5, 7, 10, 12, 15, 17, 19, 21, 23, 25, 27, 29, 31 and 33 without prejudice or disclaimer of the subject matter. In particular, Applicant has incorporated the recitations of the canceled claims into the respective independent claims.

Applicant respectfully traverses the above rejections based on the pending claims and will discuss the rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not raise any new issues requiring further search or consideration.

As noted above, by the present Response, Applicant has amended independent claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30 and 32 for consideration by the Examiner. These claims, as noted above, now recite, *inter alia*, a scanner, a start actuator and a controller that, in response to the start actuator being operated, converts the image data scanned by the scanner into a format for e-mail transmission. Adequate and sufficient support for these features is found in the original disclosure at least in paragraph [0021] of the specification.

Applicant's claims 1, 3-4, 6, 8-9, 11, 13-14, 16, 18, and 20 generally relate to (using the terminology of claim 1 as a non-limiting example) an image data communication apparatus connected to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network. The e-mail includes a mail from command and a mail message. The image data communication apparatus includes a scanner which scans the image data. The image data communication apparatus includes a memory which stores a default e-mail address. The memory is within the image data communication apparatus.

The image data communication apparatus includes a panel which inputs an e-mail address of a user into the image data communication apparatus and that includes a start actuator. The image data communication apparatus further includes a controller which, in response to the start actuator being operated, controls the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission. The controller sets the default e-mail address into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel. On the other hand, the controller sets the e-mail address of the user, input by the panel into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is selected. The mail address of the user is distinct from an e-mail address of the image data communication apparatus. Thus, the e-mail address of the user, set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. Thus, reply is returned to the e-mail address of the user, and is not returned to the e-mail address of the image data communication apparatus. Claims 22, 24, 26, 28, 30 and 32 recite related methods.

Regarding the rejection of claims 1-33 on the ground of nonstatutory obviousness-type double patenting, Applicant has filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) to obviate the judicially created double patenting rejection. The terminal disclaimer includes a provision that any patent granted on the present application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

Submission of such Terminal Disclaimer should not be taken as an indication of Applicant's acquiescence with the propriety of the obviousness-type double patenting rejection.

Rather, Applicant has submitted the Terminal Disclaimer solely in order to obtain early allowance of the claims of the present application.

In fact, Applicant respectfully submits that the Examiner's nonstatutory obviousness type double patenting rejection is inappropriate. In this regard, Applicant notes that the claims of the patent do not recite the start button (actuator) recited in the claims of the present application. Moreover, the present application does not claim opening of the attached image data at a receiving apparatus. Accordingly, at least for the above-noted reasons, it is respectfully submitted that the scope of the claims of the present application is significantly different than the scope of the claims of the cited OGAWA patent and thus a nonstatutory obviousness type double patenting rejection is inappropriate. Nevertheless, as noted above, and solely in order to expedite the allowance of the claims in the present application, Applicant has filed a Terminal Disclaimer.

Regarding the rejection of claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. in view of BAEK et al., LEE et al. relates to a system in which individual users 10 can access the directory service 24 to obtain directory information about a large number of people and businesses (col. 2, lines 16-33). The users 10 can register basic directory information, i.e., names, addresses, and telephone numbers into the storage 30 of the directory service 24 (col. 2, lines 34-43, col. 4, lines 63-67, and col. 5, lines 1-16). The users 10 can search in the directory service 24 for the directory information of other users 10 (col. 2, lines 43-65, col. 6, lines 48-67 and col. 7, lines 1-12).

The disclosure of LEE et al. enables users to receive e-mail messages from senders without requiring the users to reveal their e-mail addresses. According to the teachings of LEE et al., the directory disclosed therein restricts the display of the e-mail address of the user and

thus allows a user to send a message to a recipient without revealing his own e-mail address. This is, however, rather remote from the combination of features of Applicant's invention that are recited in the various claims pending herein.

In particular, LEE et al. does not disclose an image data communication apparatus which, *inter alia*, includes a controller that sets the mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached, the e-mail address of the user being distinct from an e-mail address of the image data communication apparatus, whereby the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the e-mail address of the user, and not being returned to the e-mail address of the image data communication apparatus.

Rather, in LEE et al., the sender sets a sender's e-mail address into a "Reply-to" field; therefore, a reply to a sending e-mail is returned to the sender that has transmitted the sending e-mail (col. 7, lines 26-63). In other words, LEE et al. merely disclose a conventional reply mail.

On the other hand, and in stark contrast to LEE et al., the present invention recites an image data communication apparatus which includes, *inter alia*, a controller that sets the e-mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached. The e-mail address of the user is distinct from an e-mail address of the image data communication apparatus. Thus, in the present invention, the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. As a result, the reply is returned to the e-mail address of the user, but not to the e-mail address of the image data communication apparatus.

Further, LEE et al. does not disclose an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start actuator. LEE et al. does not relate to a system that has any need whatsoever for a scanner. Also then inherently, LEE et al. contains no teachings regarding conversion of the scanned image data into a format for e-mail transmission. LEE et al. is directed only to a directory system for an e-mail system and even though scanners are well known, per se, there is no reason for one of ordinary skill in the art to incorporate a scanner into the system of LEE et al. LEE et al. also thus inherently does not disclose an image data communication apparatus which, when the start actuator is operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the image data scanned by the scanner into a format for e-mail transmission. Rather, LEE et al. merely disclose individual users 10, servers 16 and 18, Internet providers 20 and 26, and the directory service 24. Thus, LEE et al. does not even disclose a device which has a scanner that scans image data and has a panel that includes a start actuator and which, in response to the start actuator being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission. In other words, LEE et al. merely relates to e-mail transmission by a personal computer, but does not disclose or even suggest e-mail transmission by an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start actuator.

Further, as the Examiner admitted in the outstanding Official Action mailed on March 6, 2007, LEE et al does not disclose a controller that sets the default mail address into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel.

As noted above, LEE et al. deals with nothing more then conventional e-mail reply procedures. In this regard, in addition to not including a scanner, which is recited in the pending claims, and in addition to not controlling the scanner in a manner recited in Applicant's claims, Applicant further notes that LEE et al. does not set an e-mail address of a user input by a panel from a memory into a mail message of an e-mail to which image data is attached.

LEE et al. merely discloses a mechanism that copies a previously entered sender's e-mail address into a from field and a reply field. This is nothing more then conventional e-mail technology.

However, LEE et al. does not in any way provide at least a controller that is configured to set an e-mail address of a user, that is input by a panel, into a mail message of an e-mail to which image data is attached, with the e-mail address of the user being distinct from an e-mail address of the image data communication apparatus. Nor does LEE et al. disclose that the e-mail address of the user that is set into the mail message of the e-mail can be used as a destination for a reply that is sent from the receiving apparatus, the reply being returned to the e-mail address of the user but not returned to the e-mail address of the image data communication apparatus.

In LEE et al., as can clearly be seen in column 7, lines 26-41, the sender (i.e., "From:") is the same as the reply. Accordingly, LEE et al. further fails to comply with the explicit recitation of Applicant's claims that the e-mail address of the user which is used as a destination for reply to the e-mail be distinct from the e-mail address of the image data communication apparatus which, as recited in the claims, is configured to transmit image data to a receiving apparatus via the network. For these additional reasons, it is respectfully submitted that LEE et al. is an inappropriate basis for the rejection of any of the claims in the present application.

Thus, the pending claims are clearly distinct from LEE et al.

Therefore, it is respectfully submitted that the features recited in Applicant's resubmitted claims are not disclosed in LEE et al. cited by the Examiner.

BAEK et al. fails to disclose that which is lacking in LEE et al. BAEK et al. relates to a facsimile system which prints a user's unique name at the top of the document received by a recipient. BAEK et al. also discloses the automatic dialing number "FF" as a default number.

However, BAEK et al. relates, not to an Internet facsimile apparatus, but to an ordinary facsimile apparatus. Thus, BAEK et al. does not disclose and thus cannot teach or render obvious at least a controller that sets the default e-mail address into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel. Further, BAEK et al. also does not disclose at least a controller that sets the e-mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is input by the panel (i.e., as opposed to when the e-mail address of the user is not selected by the panel).

On the other hand, the pending claims (e.g., claim 1) recite a controller that sets the default e-mail address into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel. The pending claims also recite a controller that sets the e-mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is input by the panel.

In setting forth the rejection, the Examiner admitted that LEE et al. does not disclose a memory configured to store a default e-mail address. The Examiner however asserts that this feature is known and relies on BAEK et al. for this limitation. However, the Examiner, in discussing BAEK et al., notes that it refers to a default "number", not to a default e-mail address.



In fact, and as noted above, BAEK et al. has no relationship to an e-mail communication system at all. BAEK et al. is merely directed to a conventional facsimile system. Thus, the default is a "telephone number" and accordingly, would not logically be inserted into the mail message of an e-mail because BAEK et al. does not deal with e-mails at all. BAEK et al. merely prints the default phone number on a page. BAEK et al. does not set a default "telephone number" into a mail message as is required, *inter alia*, by the recitations of Applicant's claims.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims are not taught or disclosed in BAEK et al. cited by the Examiner.

The pending claims are also submitted to be patentable over the Examiner's proposed combination. In particular, since neither LEE et al. nor BAEK et al. discloses the features recited in Applicant's pending claims, the pending claims are clearly distinguished over the combination of LEE et al. and BAEK et al.

Therefore, Applicant submits that even if one attempted to combine the teachings of LEE et al. and the teachings of BAEK et al. in the manner suggested by the Examiner, such a combination would fail to render Applicant's invention obvious, since such a combination would not include at least a controller that sets the default e-mail address into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is not input by the panel and sets the e-mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is selected by the panel, as recited in the claimed combinations.

Moreover, the Examiner's rejection also lacks the proper motivation required to support a combination rejection under 35 U.S.C. § 103. In particular, the Examiner has set forth no reason whatsoever why one would combine the device of LEE et al. which does not relate to a

scanner or to an actuator and does not relate to conversion of a scanned image data into format for e-mail transmission with the device of BAEK et al. which deals with a mechanism which involves only conventional facsimile transmission. The device of LEE et al. has no need for the teachings of BAEK et al. and the device of BAEK et al. has no need whatsoever for the teachings of LEE et al. Each is a separate, fully operational device from a different field of technology.

Additionally, the Examiner has provided no motivation or suggestion flowing from the prior art to make the claimed combination. The justification that the Examiner set forth as a motivation appears to flow from Applicant's disclosure rather from the prior art as is required. In other words, the justification or motivation set forth in the Examiner's rejection does not flow from either LEE et al. or BAEK et al.

Moreover, even if the disclosure of LEE et al. could be combined with the disclosure of BAEK et al., the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In the present situation, the relied upon references fail to suggest such a desirability. Accordingly, for this additional reason, Applicant respectfully submit that the Examiner has improperly combined the disclosures of LEE et al. and BAEK et al. Moreover, as set forth previously, even if combined as proposed by the Examiner, the combination of features recited in each of Applicant's claims are not taught or rendered obvious by the references.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

### **SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled some rejected claims without prejudice or disclaimer, and has amended other rejected claims for reconsideration by the Examiner. With respect to the rejected claims, Applicant has pointed out the features thereof and has contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

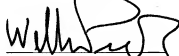
In regard to the nonstatutory obviousness type double patenting rejection, Applicant has traversed the same based on dissimilarities in the claimed subject matter of the present application as compared to the claimed subject of the patent relied upon by the Examiner. Nevertheless, Applicant has submitted an executed Terminal Disclaimer to obviate the Examiner's obviousness type double patenting rejection.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Hidehiko OGAWA

A handwritten signature in black ink, appearing to read 'Will Bernstein', written over a horizontal line.

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